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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,242	01/14/2005	Miki Ogawa	03500.017473.	7202
5514 7590 07/09/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
EMPIE, NATHAN H				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
07/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/521,242

Applicant(s)

OGAWA, MIKI

Examiner

NATHAN H. EMPIE

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3, 5 and 17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 6/11/09
13. ☐ Other: _____.

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792

/N. H. E./
Examiner, Art Unit 1792

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments filed 6/24/09 have been fully considered but they are not persuasive.

In response to applicant's argument that Miyata is nonanalogous art (pg 4-7 of 6/24/09 Remarks), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Furthermore, prior art that is in a field of endeavor other than that of the applicant or solves a problem which is different from which the applicant was trying to solve, may also be considered for the purposes of 35 U.S.C. 103 "[t]he first error... in this case was... holding that courts and patent examiners should look only to the problem the patentee was trying to solve. The Court of Appeals failed to recognize that the problem motivating the patentee may be only one of many addressed by the patent's subject matter... The second error [was]... that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007). In this case, Miyata is solely relied upon for the teaching of providing a glass substrate with a polyimide film that is treated with rubbing which gives alignment control to the substrate, which is taught as desirable in that it provides an ordered mesoporous films with aligned channels (see, for example, pg 1610, first col, and "Experimental Section"). The result of the film formation process is an aligned structured with oriented channels aligned with respect to the substrate. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated using a glass substrate provided with a precoat of a rubbed polymer film, as taught by Miyata, as the glass substrate taught in the method of Stucky in view of Nogues as it would provide a desirable ordered alignment for the mesostructured / mesoporous coating. Such an incorporation would result in a method which would possess a substrate having a capability of orienting aggregate of the surfactant material, and one wherein aggregates of the surfactant material would be oriented in the predetermined (rubbing) direction. Therefore the examiner asserts Miyata is analogous art. Further with respect to the applicant's arguments directed toward the prior art being directed toward only silica-based methods, the examiner asserts that the primary reference (Stucky) has explicitly taught the "non-silica" material (tin) containing structures, and all of the prior art references have taught at least metal-alkoxide-based sol-gel type reactions. The examiner further reminds the applicant that the rejection of claims 1,3,5, and 17 are over Stucky in view of Nogues and Miyata, and, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant further argues (pages 7-8) that none of Stucky, Nogues, nor Miyata individually have taught the formation of metal oxide crystals on the pore walls, nor that the artisan would not expect nor understand from Nogues that metal oxide crystals would form on the walls. The examiner reminds the applicant that the rejection of claims 1,3,5, and 17 are over Stucky in view of Nogues and Miyata, and, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant argues that individually Miyata does not teach metal oxide crystals forming on pore walls (pg 7). The examiner agrees that individually Miyata does not explicitly teach metal oxide crystals forming on pore walls following the high humidity treatment of Nogues, but when incorporating such a step into the method of Stucky, such metal oxide crystals would inherently form as the combination of Stucky in view of Nogues and Miyata teaches a coating chemistry and conditions substantially identical to those of the claimed invention which are needed to form the metal crystals (from preparation of the reactant solution containing a metal compound and a surfactant through to holding the substrate in an atmosphere containing water vapor, as described in the rejection above). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not" *In re Spada*, 15 USPQ2d 1655 1658 (Fed Cir. 1990). Further In response to applicant's argument that "Nogues utilizes high humidity for the drying step and not for forming crystals of an oxide", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The examiner maintains the provisionally rejected, nonstatutory obviousness-type double patenting rejection as the applicant has not yet submitted a terminal disclaimer signed by the assignee in full compliance with 37 CFR 3.73(b).

As to the dependent claims, they remain rejected as no separate arguments are provided.

The examiner maintains the final rejection of 2/25/09.